

2008-1461
(Serial No. 09/871,349)

UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

IN RE PAUL J. BRYAN

Appeal from the United States Patent and Trademark Office,
Board of Patent Appeals and Interferences.

BRIEF FOR APPELLEE
DIRECTOR OF UNITED STATES PATENT AND TRADEMARK OFFICE

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Illustrative Claim

1. A game board and game, comprising:

(a) a game board having a starting area, a network of irregular paths that lead from the starting area; and a central performing stage located generally centrally on the game board and connected to at least one segment of the network of paths;

(b) the network of paths including a series of segments wherein each segment is broken down into increments and wherein at least some of the increments include indicia formed thereon that dictate an action for landing on a particular increment;

(c) a series of tokens provided with the game board wherein a token may be assigned to one player and during the course of a game the token is advanced along one or more of the segments of the network of paths;

(d) at least one die that is used to determine the number of increments that a player's token can be advanced during the course of the game;

(e) a supply of money that during the course of the game is distributed to the players;

(f) a deck of "Consequence" cards that are keyed to certain increments on the network of paths, each "Consequence" card having indicia thereon that sets forth a consequence and wherein a player landing on an increment that calls for drawing a consequence card must comply with the directive set forth on the drawn consequence card;

(g) a deck of "Band Member" cards with the deck being divided into a series of groups with each group of "Band Member" cards designating members of a band;

(h) a series of "Band Equipment" cards with each card designating band equipment; and

(i) wherein the object of the game is for each player to advance his or her token along the network of paths and reaches the central stage with a predetermined number of one group of "Band Member" cards and a "Band Equipment" card.

A20-21 (emphasis added).

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RULE 47.5 STATEMENT OF RELATED CASES

(a) No other appeal from the Board of Patent Appeals and Interferences in connection with the patent application on appeal has previously been before this or any other court.

(b) There is no known related case pending in this or any other court.

I. STATEMENT OF THE ISSUES

Claims 1 and 11 are directed to a board game with common playing items such as cards and player-tokens which travel along paths appearing on a game board that utilizes a musical band theme. However, a prior art patent issued to Elrod similarly discloses a board game with playing items such as tokens, cards and paths appearing on a game board that likewise employs a musical band theme. The Board of Patent Appeals and Interferences held that Elrod renders claims 1 and 11 obvious under 35 U.S.C. § 103.

As to dependent claim 6, a prior art patent issued to Hunsberger similarly discloses using colors to distinguish among different types of playing cards. The Board held that Elrod and Hunsberger render this claim obvious under § 103.

Thus, the issue is whether the Board's findings underlying its obviousness conclusions are supported by substantial evidence of record.

II. STATEMENT OF THE CASE

In 2001, Paul J. Bryan ("Bryan") filed a patent application with the United States Patent and Trademark Office ("USPTO") entitled "GAME BOARD

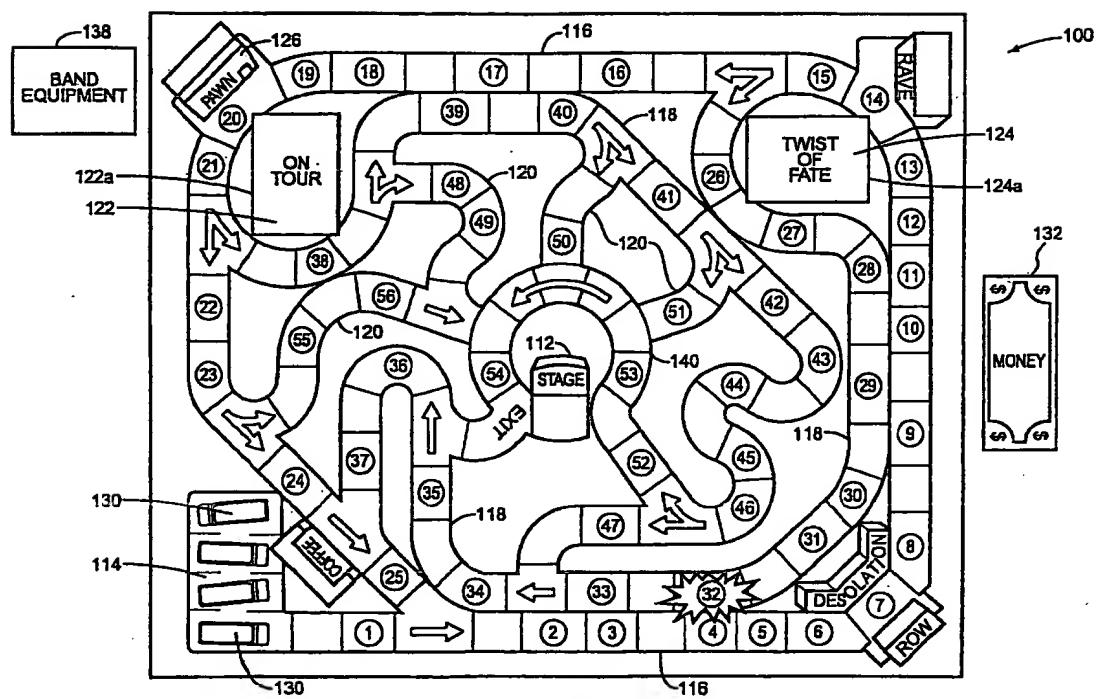


FIG. 1

AND GAME HAVING A TOURING BAND THEME.” A34-57.¹ The USPTO examiner rejected pending claims 1-11 and 13-15 as obvious under 35 U.S.C. § 103. A3.

The Board affirmed the examiner’s obviousness rejections. A1-15. Bryan then appealed the Board’s decision to this Court.

III. STATEMENT OF FACTS

A. Claimed Invention: Board Game For Moving Players’ Music Bands To A Concert Stage

Bryan’s patent application describes a game board and game in which the players’ objective is to advance their player-tokens from the starting point on the board to the end point, *i.e.*, “the performing stage.” A36. During the game, each player is also attempting to assemble a music band. *Id.*

Figure 1 (A49, opposite) shows a game board 100 with various travel paths 116, 118, 120 and 140 drawn around the board. A38, lines 1-14. The paths have individual rectangles or increments, with certain rectangles “includ[ing] some form of indicia thereon.” A39, line 20 - A40, line 1. Bryan’s specification states examples for such rectangles with possible consequences for players. A40; A50-51.

¹ References to the Appendix are made by “A ___” and to Bryan’s brief by “Br. at ___.”

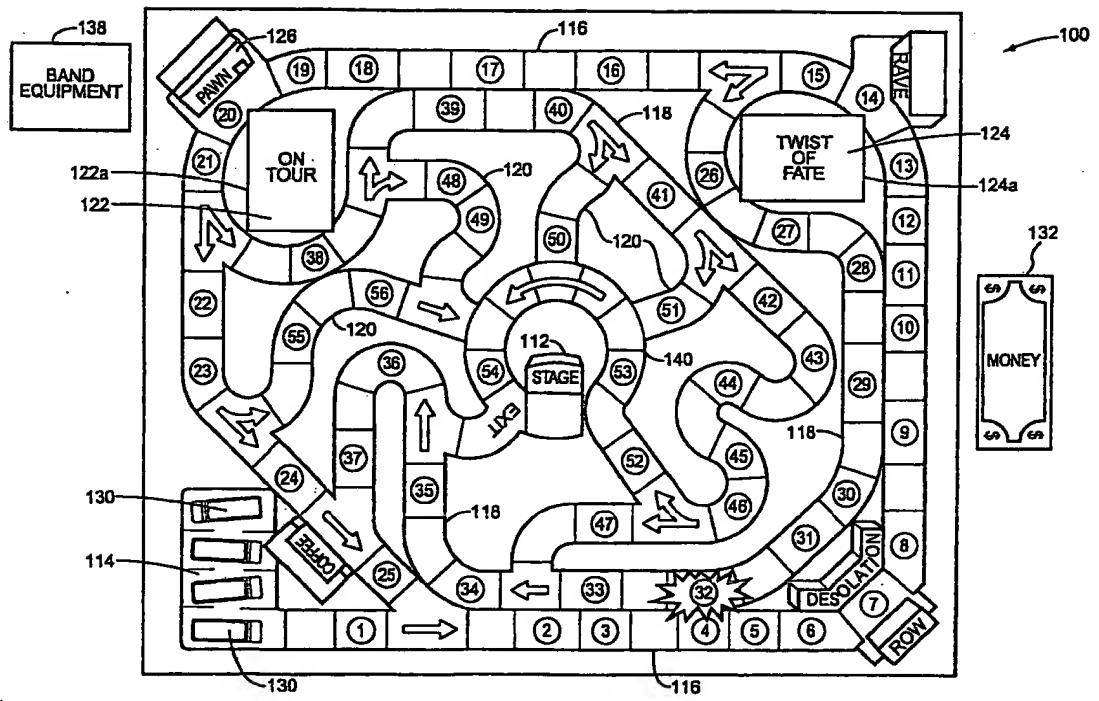


FIG. 1

Performing stage 112 also appears on the board. A37, lines 20-21.

Players for the game have tokens 130 to move around the board. A38, lines 14-21.

Decks of cards 122 and 124 are placed on the game board. A39, lines 5-15.

Cards 122 are identified as “On Tour” and cards 124 are “Consequence” cards (also named “Twist of Fate”). A39, lines 5-9. There are “Band Equipment” cards 138. A49. For the consequence cards, Bryan’s specification states “an exemplary list of the indicia” appearing thereon. A41, lines 4-5. See also A41-45 (showing printed examples on the cards beginning with “Wading in the Velvet Sea; Collect \$1,000.00” etc.).

The other decks, 122 and 138, are only generally described in the specification, without listing examples of the matter printed thereon. A39-40. The specification also notes that dice 128 are used in playing the game to determine the number of spaces on the board a player’s token may advance. A39, lines 21-23. Bryan’s specification also states that money 132 is used by the players with tokens. A40, lines 18-22.

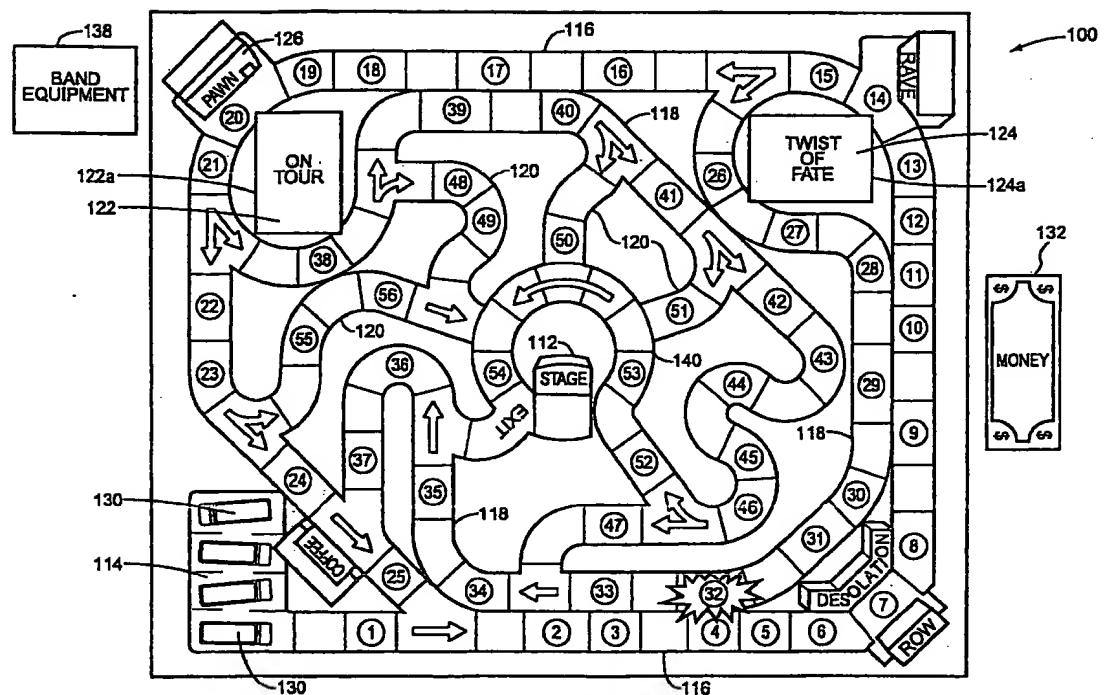


FIG. 1

Referring to Bryan's Figure 1 (A49), reproduced on the facing page,
independent claim 1 reads:

1. A game board and game, comprising:
 - (a) a game board **100** having a starting area, a network of irregular paths **116, 118, 120, 140** that lead from the starting area **114**; and a central performing stage **112** located generally centrally on the game board and connected to at least one segment of the network of paths;
 - (b) the network of paths **116, 118, 120, 140** including a series of segments wherein each segment is broken down into increments and wherein at least some of the increments include indicia **1-54** formed thereon that dictate an action for landing on a particular increment;
 - (c) a series of tokens **130** provided with the game board wherein a token may be assigned to one player and during the course of a game the token is advanced along one or more of the segments of the network of paths;
 - (d) at least one die that is used to determine the number of increments that a player's token can be advanced during the course of the game;
 - (e) a supply of money **132** that during the course of the game is distributed to the players;
 - (f) a deck of "Consequence" cards **124** that are keyed to certain increments on the network of paths, each "Consequence" card having indicia thereon that sets forth a consequence and wherein a player landing on an increment that calls for drawing a consequence card must comply with the directive set forth on the drawn consequence card;
 - (g) a deck of "Band Member" cards **122** with the deck being divided into a series of groups with each group of "Band Member" cards designating members of a band;
 - (h) a series of "Band Equipment" cards **138** with each card designating band equipment; and
 - (i) wherein the object of the game is for each player to advance his or her token along the network of paths and reaches the central stage with a predetermined number of one group of "Band Member" cards and a "Band Equipment" card.

A20-21 (emphasis and drawing numbers added).

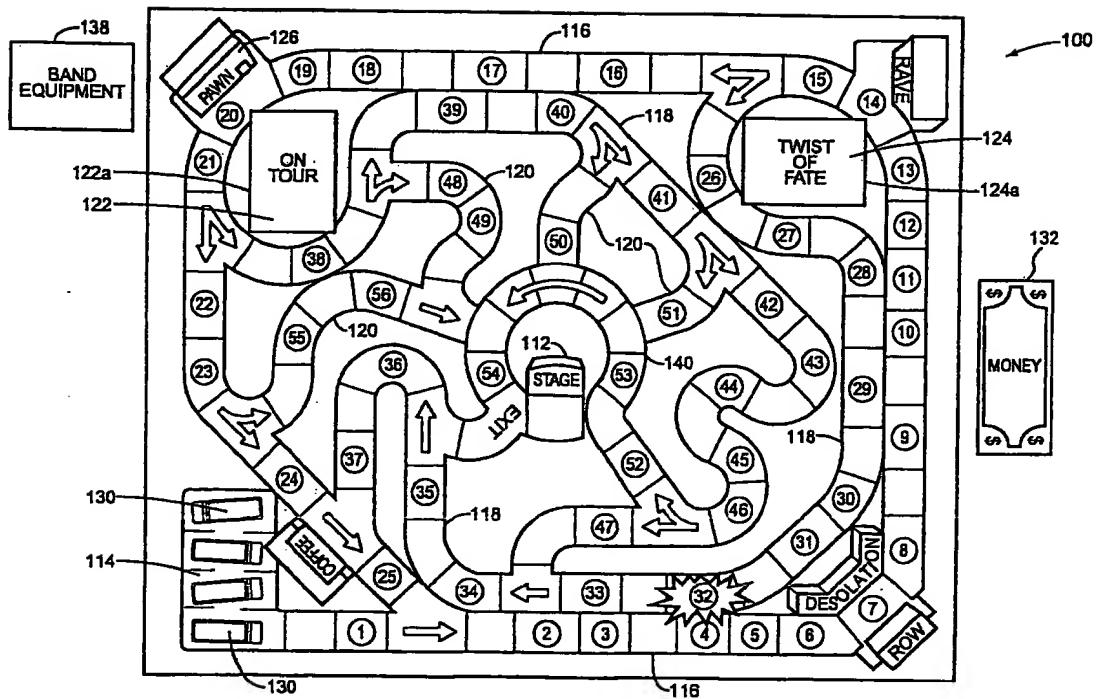


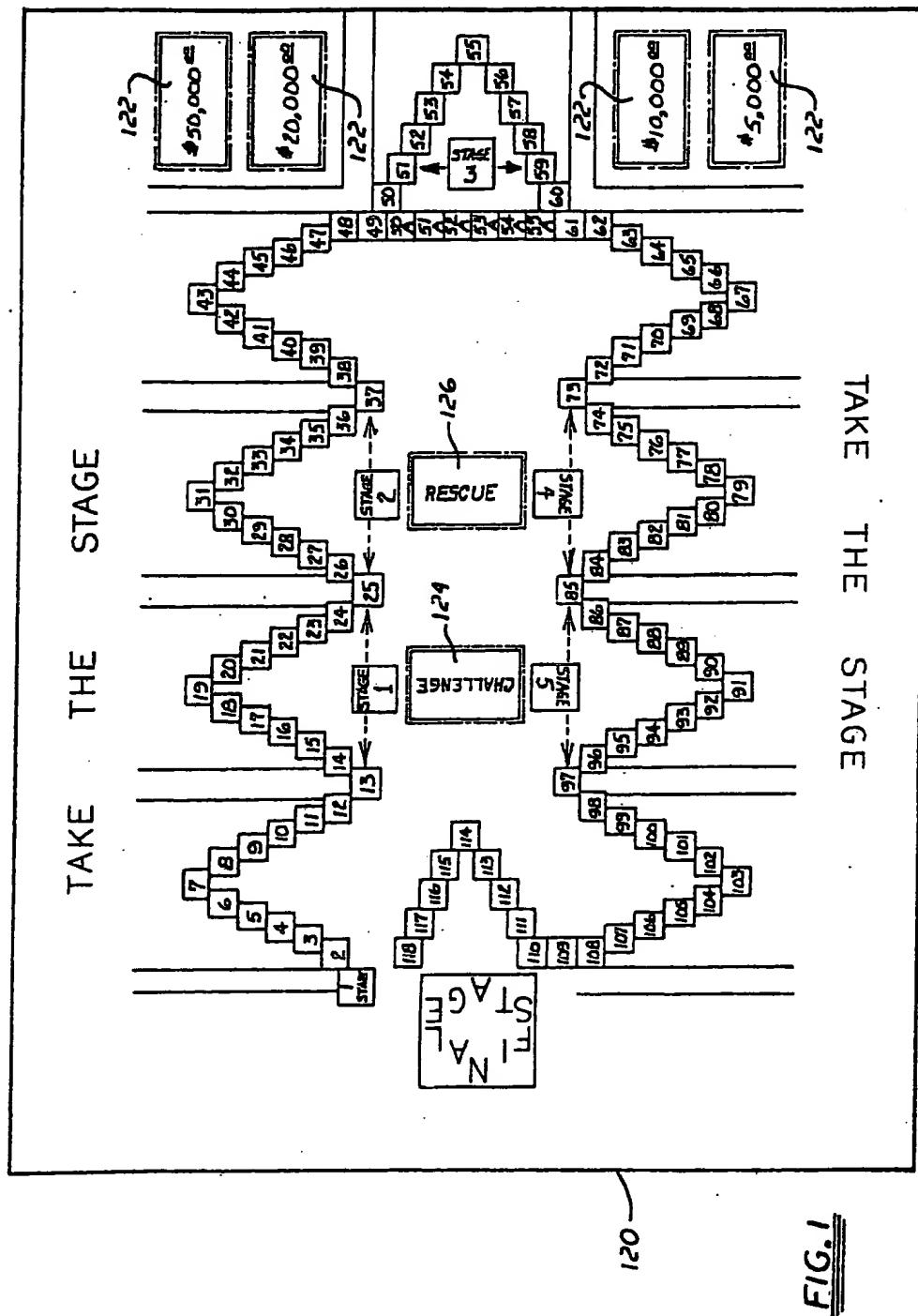
FIG. 1

Dependent claim 6 recites the additional limitation of color coding the Band Member cards. A21.

Independent claim 11 reads:

11. A game board and game comprising:
a game board **100** having a performing stage **112** and a network of paths **116, 118, 120, 140** including a plurality of paths that lead to the performing stage; a series of tokens **130** for being advanced from a starting point **114** along paths along the network of paths with the object being to advance the tokens to the performing stage; and at least two decks of cards, a first deck of cards and a second deck of cards, and wherein the first deck of cards include "Consequence" cards **124** that are key to increments designated along the respective paths of the network of paths and the second deck of cards being collectible cards that are collected and exchanged by the players during the course of the game; and wherein the second deck of cards are "Band Member" cards **122** and include a plurality of groups of cards with each group of cards representing a band and the members of the band, and wherein the object of the game is to arrive at the performing stage with a certain number of cards representing a band and its members.

A22-23 (emphasis and figure 1 drawing numbers added). As seen above, claim 11 appears to be broader than claim 1. That is, claim 11's limitations are in claim 1, except some of claim 1's elements have been omitted, e.g., dice and money not appearing in claim 11.



B. Prior Art

1. **Elrod: Board Game For Moving Players' Music Bands To A Concert Stage**

U.S. Patent 4,998,736 issued to R. Brent Elrod ("Elrod") (A24-33) is directed to a board game in which players move their player tokens from a start box to a "final stage," while assembling a music band along the way. A27, col. 1, lines 25-55.

Referring to Elrod's Figure 1 (A25), reproduced on the facing page, Elrod discloses a game board 120, with "START" box 1 and a "FINAL STAGE." A27, col. 2, lines 7-10, A29, col. 6, line 41. There is a path from the starting area to the final stage. A27-29, cols. 2-6. Rectangles 1-118 form this path and Elrod states individual "directions" for each rectangle. A27, col. 2, line 10 - A29, col. 6, line 17 ("1. START . . . 118. YOUR ALBUM IS CERTIFIED PLATINUM!!!!!! COLLECT \$250,000").

The players of the game each use a "concert platform 128 to act as his moving piece," i.e., a player's token. A29, col. 6, lines 28-30. Dice 142 are used by the players for moving the concert platforms around the game board. A29, col. 6, lines 34-68. Money 122 is also used by the players of the game. A29, col. 6, lines 18-24.

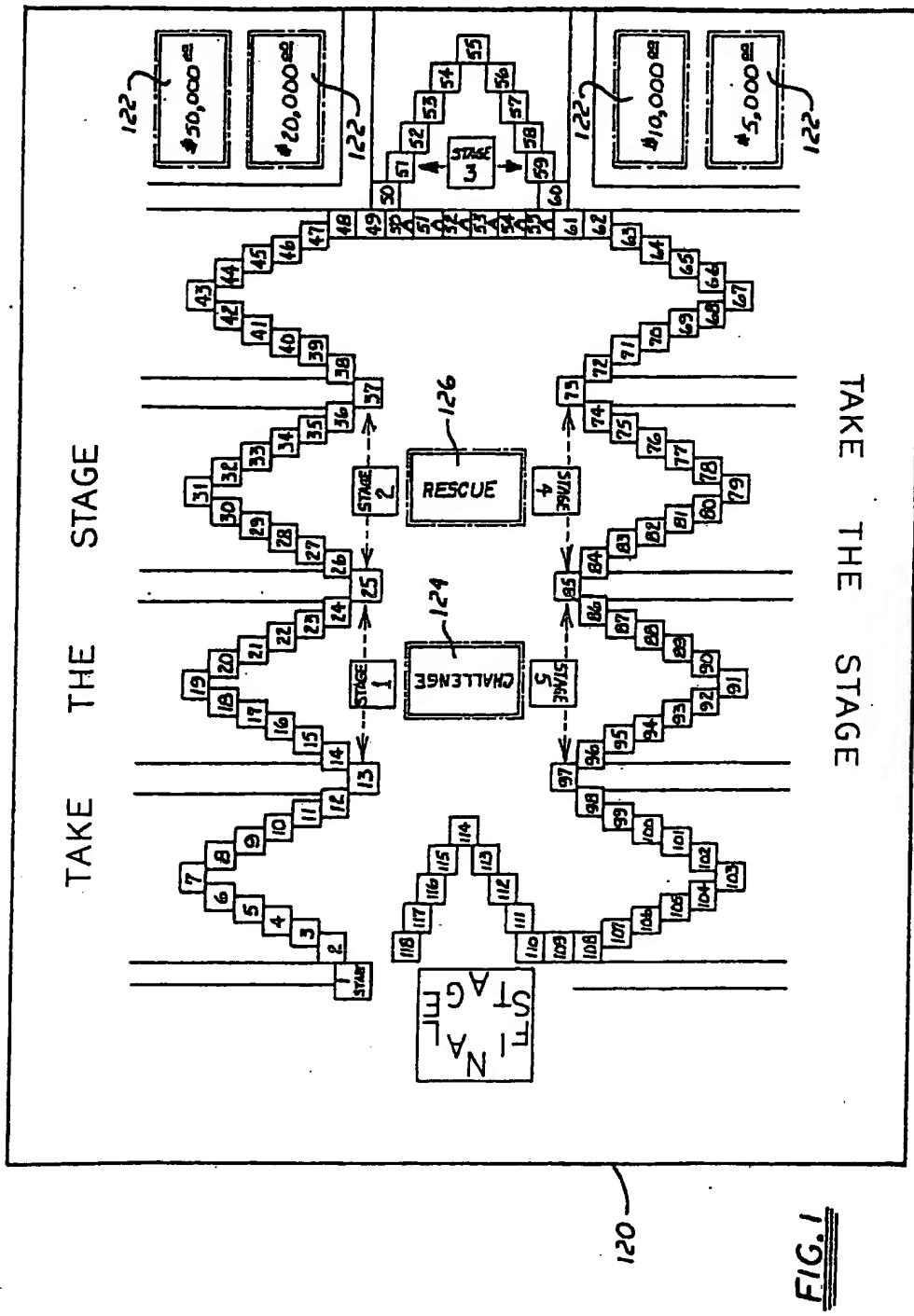


FIG. 1

On his game board, Elrod has challenge cards 124 and rescue cards 126. A29, col. 6, lines 25-27 and 50-52. Elrod discloses that his rescue cards 126 are broken down into the following groupings: (i) rescue me; (ii) block; and (iii) name. A30, col. 7, line 38 - col. 8, line 31. In particular, Elrod discloses fifty (50) rescue cards, each with indicia on it. Id.

Elrod further describes his challenge cards 124 as: (i) self-challenge; (ii) challenge opponent; and (iii) a variety of others. A30, col. 8, line 31 - A31, col. 10, line 16. Over three columns of Elrod's patent, he discloses fifty (50) challenge cards, each with indicia printed on it. Id.

Thus, Elrod similarly discloses that players of his musical board game use tokens, dice, money and cards to move around paths-with-indicia on a board.

2. Hunsberger: Board Game Using Color Coded Cards

For dependent claim 6, the Board applied U.S. Patent 6,279,908 issued to Glenn E. Hunsberger ("Hunsberger") (A58-65). Hunsberger is directed to a board game. A62, col. 2, lines 57-59. Like most board games, Hunsberger discloses a game board with playing spaces on a path of travel on the board. A62, col. 2, lines 60-64. The spaces are color coded. A62, col. 2, lines 64-67. Tokens and a die are used. A63, col. 3, lines 1-7.

Sets of cards are used and the sets are in different colors, i.e., color-coded, in order to distinguish one set from another set. A63, col. 3, lines 12-16.

Hunsberger recites yellow, red and blue as example colors for the cards. Id.

C. Board Decision

The Board held that Elrod renders independent claims 1 and 11 obvious, and that Elrod and Hunsberger render dependent claim 6 obvious. A1, 15.

As to claim 1, the Board found that Elrod discloses various types of cards used in a board game. A8. For example, as discussed by the Board, Elrod describes Challenge cards, Self Challenge cards, Challenge an Opponent cards, Rescue cards, Block A cards, Name A cards. A8. The Board found that these various categories of cards, all disclosed in Elrod, meet the identification of Consequence, Band Member and Band Equipment cards in claim 1. A7-8. The Board applied this Court's caselaw and held that indicia on the various cards, albeit only recited in Bryan's specification (see A41-45), did not patentably distinguish from the playing cards in Elrod and its various sets of indicia (A27-29). A9-10. The Board found that indicia in Bryan's patent application was non-functional printed matter, which did not distinguish claim 1 from Elrod. A7-8. Simply put, the unclaimed indicia on the cards did not patentably distinguish claim 1 from the prior art.

As for the other features found in claim 1, the Board found that Elrod also discloses on his game board paths to travel from a starting area to a final stage area. A10. The Board rejected Bryan's argument that indicia on the travel paths is functional printed matter not found in Elrod. A9. In fact, Elrod discloses similar indicia on his travel paths, as found by the Board. A9-10. Since Elrod discloses the other limitations of player tokens and dice, the Board concluded that the invention recited by claim 1 would have been obvious. A10.

The Board also considered Bryan's declaration, made by himself as the inventor, but found it unconvincing, given that the declaration misunderstood the functional relationship requirement for printed matter. A7-9.

As to claim 11, which is broader than claim 1, the examiner applied the printed matter doctrine and found "the difference between the claimed invention cards, game path and the prior art resides in the meaning on the information on the cards," as determined by the Board. A11. The Board found that the "'Band Member' card limitation . . . is a description of the indicia printed on the card.'" A11. The Board further found there was "no claimed or functional relationship between the card or other elements claimed and the indicia printed on the card." A11. Thus, the Board concluded that Elrod renders claim 11 obvious as well. A11.

Finally, as to dependent claim 6, the Board found that Hunsberger discloses color coding cards for his game, in order to distinguish among the decks of cards.

A14. The Board further found that such color coding would yield the predictable result of readily grouping the different decks of cards. Id. Thus, the Board concluded that claim 6 also would have been obvious. Id.

IV. SUMMARY OF ARGUMENT

Apparatus claim 1 recites the structure of a game board, travel paths with indicia, a starting area, performing stage, tokens, dice and various playing cards, having the theme of musical bands. Elrod discloses the foregoing structural features. To the extent there is any difference between Elrod's disclosure and claim 1, the difference lies only in reciting types of printed matter. As the Board found, the printed matter bears no functional relationship to the playing cards or game board, thereby precluding the broadly-claimed printed matter from having any patentable weight. Accordingly, the matter does not patentably distinguish in a non-obvious manner over Elrod. In sum, Elrod renders obvious the breadth of apparatus claim 1.

As to independent claim 11, the claimed structure is similar to that of claim 1, but with fewer limitations. Thus, as the Board found, Elrod discloses the

structural features of claim 11, and the recited type of printed matter fails to render the claim non-obvious.

Finally, as to dependent claim 6, which adds the limitation of color coding cards, Hunsberger teaches to color-code cards for the benefit of distinguishing one deck of cards from another deck. Thus, the Board's findings as to claim 6 are also supported by substantial evidence, and Bryan has failed to show any error in the Board's obviousness conclusion for claim 6.

V. ARGUMENT

A. Standard of Review

Bryan bears the burden of demonstrating reversible error by the Board with respect to either a legal conclusion (reviewed de novo) or a factual finding (reviewed for substantial evidence). In re Gartside, 203 F.3d 1305, 1315-16 (Fed. Cir. 2000). What a prior art reference discloses is a factual inquiry. Para-Ordnance Mfg., Inc. v. SGS Imp. Int'l, Inc., 73 F.3d 1085, 1088 (Fed. Cir. 1995). Whether claimed printed matter has a functional relationship with the substrate is also a question of fact. See In re Gulack, 703 F.2d 1381, 1386 (Fed. Cir. 1983).

This Court reviews Board factual findings for substantial evidence. 5 U.S.C. § 706(2)(E); Gartside, 203 F.3d at 1315. “Substantial evidence is something less than the weight of the evidence but more than a mere scintilla of evidence,” In re Kotzab, 217 F.3d 1365, 1369 (Fed. Cir. 2000), and “means such relevant evidence as a reasonable mind might accept as adequate to support a conclusion,” Consol. Edison Co. v. Nat’l Labor Relations Bd., 305 U.S. 197, 229 (1938). “[T]he possibility of drawing two inconsistent conclusions from the evidence does not prevent an administrative agency’s finding from being supported by substantial evidence.” Consolo v. Federal Maritime Comm’n, 383 U.S. 607, 620 (1966). And “[i]f the evidence in record will support several reasonable but contradictory conclusions,” this Court “will not find the Board’s decision unsupported by substantial evidence simply because the Board chose one conclusion over another plausible alternative.” In re Jolley, 308 F.3d 1317, 1320 (Fed. Cir. 2002).

The Board must give claims their “broadest reasonable” interpretation consistent with the specification. In re Crish, 393 F.3d 1253, 1256 (Fed. Cir. 2004); In re Morris, 127 F.3d 1048, 1053-54 (Fed. Cir. 1997). This Court thus reviews the USPTO’s interpretation of disputed claim language to determine whether it is “reasonable.” Morris, 127 F.3d at 1055.

Bryan

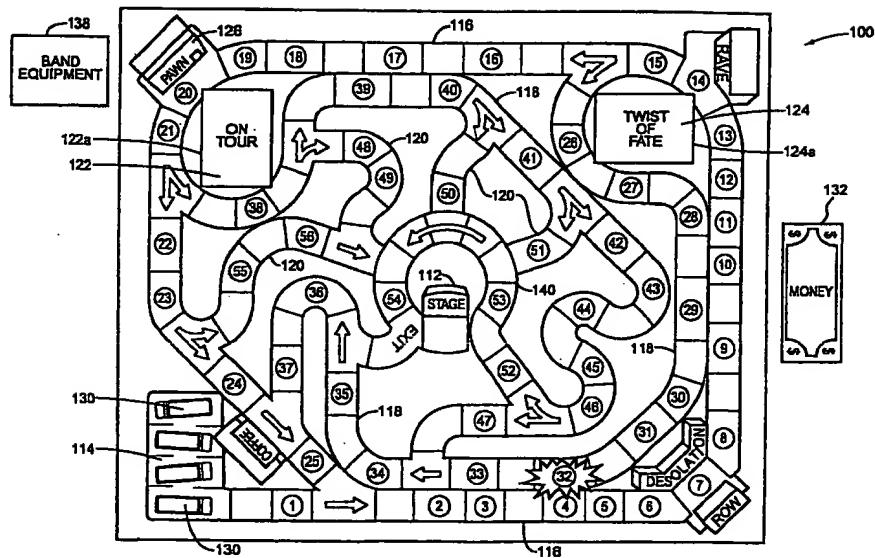
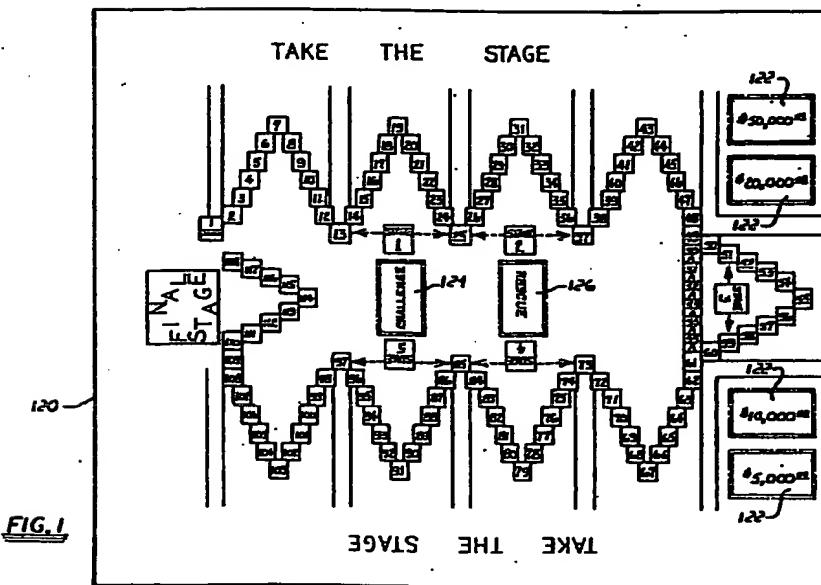


FIG. 1

Elrod



B. Claim 1 Is Directed To A Board Game Having Common Types Of Game Elements And Would Have Been Obvious In View Of Elrod

1. Elrod Renders The Structure Of Claim 1 Obvious

Claim 1 recites the following structure: (i) game board; (ii) starting area; (iii) travel paths with indicia; (iv) central stage; (v) tokens; (vi) dice; (vii) money; (viii) consequence cards with indicia; (ix) band member cards; (x) band equipment cards. A20-21.

Elrod also discloses these limitations, as found by the Board. A8-10.

Referring to Elrod's Figure 1 (A25), reproduced on the lower portion of the facing page, Elrod discloses game board 120, starting area square 1, travel path squares 1 to 118, final stage near squares 110 and 118, supply of money 122, challenge cards 124 and rescue cards 126. Elrod additionally discloses that player tokens 128 are used. A29, col. 6, lines 28-30. And, according to Elrod, dice 142 are used by the players for moving player tokens around the game board. A29, col. 6, lines 34-68.

To the extent there is any difference between Elrod and claim 1, the claim only recites types of printed matter, without stating specific printed matter.

That is, the pertinent limitations read:

“network of paths . . . wherein at least some of the increments include indicia formed thereon that dictate an action for landing on a particular increment”;

“each Consequence card having indicia thereon that sets forth a consequence”;

“each group of Band Member cards designating members of a band”; and

“Band Equipment cards with each card designating band equipment.”

A20 (emphasis added). Thus, the claim requires only types of printed matter, namely: (i) dictating indicia²; (ii) consequence indicia³; (iii) band members; and (iv) band equipment. These *types of printed matter*, however, do not patentably distinguish claim 1 from Elrod.

2. Printed Matter Must Have A Functional Relationship With The Substrate To Be Given Patentable Weight

The case law differentiates between different types of printed matter, permitting only certain categories of indicia to be given patentable weight. For example, in In re Lowry, 32 F.3d 1579 (Fed. Cir. 1994), this Court noted that in cases where printed matter did not patentably distinguish a claimed invention, it

² Bryan’s specification recites examples for the board. A50-51 (“PAY CHECK - \$2,000.00” etc.).

³ Bryan’s specification states exemplary cards. A41-45 (“Wading in the Velvet Sea” etc.).

was because those cases ““dealt with claims defining as the invention certain novel arrangements of printed lines or characters, useful and intelligible only to the human mind.”” Id., at 1583 (quoting In re Bernhart, 417 F.2d 1395, 1399 (CCPA 1969)) (emphasis added). Likewise, in In re Jones, 373 F.2d 1007, 1012 (CCPA 1967), the court distinguished between printed matter which is “structural” from “various sorts of indicia whose primary purpose is the conveying of intelligence to a reader.” (Emphasis added). Accordingly, printed matter recited in a claim that simply conveys an idea to a reader does not impart patentability to the claim.

When faced with printed matter in a claim, however, the USPTO may not simply disregard it, but instead must examine it to determine whether the printed matter is functionally related to the article upon which it is printed, thereby changing the underlying functionality of that article. This court recently reaffirmed the “functional relationship” test for printed matter:

“Where the printed matter is not functionally related to the substrate, the printed matter will not distinguish the invention from the prior art in terms of patentability.”

In re Ngai, 367 F.3d 1336, 1339 (Fed. Cir. 2004) (quoting Gulack, 703 F.2d at 1385) (emphasis added). Accordingly, the issue is whether Bryan’s indicia is functionally related to the cards or game board.

The limited case law applying this functional relationship test underscores the distinction between printed matter that simply conveys intelligence to a reader (as we have here) versus printed matter that interacts with the article upon which it is printed to transform the article into a product with a new and different function.

Ngai addressed a claim having instructions in a kit and the instructions expressly corresponded to method steps recited in another claim. 367 F.3d at 1337-38.

This Court nevertheless held that the printed matter instructions did not interrelate with the kit in a functional way and therefore were not entitled to patentable weight. Id. at 1339. The Court stated:

“Here, the printed matter in no way depends on the kit, and the kit does not depend on the printed matter. All that the printed matter does is teach a new use for an existing product.”

Id. at 1339. The Court held “[t]he critical question is whether there exists any new and unobvious functional relationship between the printed matter and the substrate.” Id. at 1338 (quoting Gulack, 703 F.2d at 1386) (emphasis added).

Other case law demonstrates examples of printed matter that have been deemed to have a proper functional relationship with the object upon which it is printed. In In re Miller, 418 F.2d 1392 (CCPA 1969), the indicia printed on the side of a cup changed the function of the cup into a specialized measuring device

to prepare fractional recipes. Id. at 1396. In Gulack, the invention was directed to a headband having a particular numerical sequence, based on an algorithm, printed on it. The Court found that the number sequence was functionally related to the headband because the circular nature of the headband illustrated the cyclical nature of the particular number sequence. Thus, the indicia functionally changed the headband into a learning tool. In addition, the number sequence on the headband changed the headband into a device for performing magic tricks based on the algorithm. 703 F.2d at 1382-83.

Furthermore, in Jones, the claimed analog-to-digital encoder disc had a pattern of transparent and opaque areas, which allowed sequences of light to pass through and be read by a photocell as the disc rotated to convert analog information into digital format. 373 F.2d at 1009-11. Jones claimed a new disc pattern designed to cure the problem of ambiguous error readings by the photocell. Id. Since the coded pattern interacted with the underlying disc to create a unique type of encoder, the court carefully explained why the Jones' patterns represented

structure and not mere indicia:

Certainly there is no ‘printing’ in this case in the form of words or other symbols intended to convey intelligence to a reader nor in the form of rulings as on a business form. The user of the disc is not supposed to contemplate it as he would a mathematical table, weighing scale chart, or the like in order to derive some information. The disc is devised, made and used as a component part of a machine utilizing optics and electronics to perform functions of which we are not fully apprised by the record. We think it is error to confuse the lines on a patent drawing, which may have the appearance of ‘printed matter,’ with functional elements of a mechanism which in use actuate other mechanisms or electrical circuits or devices intended to be illustrated by the drawing.

Id. at 1013 (emphasis added). Thus, in Jones, the printed matter on the disc did not merely convey intelligence to a reader. Instead, the disc, coded with the claimed pattern, was a component of a machine and the pattern interacted with the disc in such a way to permit a computer to convert analog information into digital format, while avoiding error readings by the machine. Accordingly, Jones’ printed matter was properly considered to be a structural limitation.

3. Since Bryan’s Indicia Merely Conveys Intelligence To A Reader, The Indicia Lacks Any Functional Relationship With The Cards And Game Board

In the present case, the Board properly found that Bryan’s printed matter lacks the functional relationship required by case law. After carefully considering Bryan’s claimed printed matter, the Board found that the indicia was simply

information conveying intelligence to a reader. See A7-8. While it is true that the printed matter on Bryan's cards serve a "function" by relaying information to a player, in patent law, what matters is whether the indicia printed on a particular article changes the character of that article, giving it a new function. Bryan's information is not the kind of printed matter contemplated in cases like Lowry, Gulack, and Miller where the printed matter changes the underlying functionality of the article upon which it is printed. Markings on a straight, wooden stick can convert the stick into a ruler, for example, thereby making those printed matter markings a structural limitation.

In the words of Lowry, Bryan's information, labeling cards in different ways, represents nothing more than "novel arrangements of printed lines or characters, useful and intelligible only to the human mind." 32 F.3d at 1583. Thus, Bryan seeks to patent the content of the information on the cards which are intelligible only to the human mind, an outcome precluded by Ngai and Lowry.

Moreover, the rejection in the present case is even stronger than the one in Ngai, since the printed matter limitations here only recite generic types of printed matter, whereas the apparatus claim in Ngai recited a very specific set of printed matter instructions, 367 F.3d at 1337-38. Since Bryan's printed matter does not have a distinct structure that alters or transforms the function of the underlying

article upon which it is printed, the printed matter is not a structural limitation which may impart patentability onto the claim.

Also, the type of indicia appearing on the game board is similarly only information for communicating intelligence to a reader. As discussed above, the limitation concerning printed matter on the board merely requires “dictat[ing] an action,” without further specificity.⁴

4. Bryan’s Arguments Are Not Persuasive

Bryan argues that his declaration (A136-38) shows that his printed matter is entitled to patentable weight and the Board erred in finding otherwise. Br. at 18. However, as the Board determined (A7-9), Bryan’s declaration misconstrues the printed matter doctrine by focusing on certain printed matter being allegedly functionally related to other printed matter. For example, the declaration states that within the sets of cards, “[t]here must be some means to distinguish one set from another set.” A138. As stated above, “[t]he critical question is whether there exists any new and unobvious functional relationship between the printed matter

⁴ Additionally, Elrod discloses indicia for dictating an action (A27, col. 2, line 7 - A29, col. 6, line 17) and multiple types of cards which set forth consequences (A30, col. 7, line 38 - A31, col. 10, line 16). Thus, Elrod discloses printed matter falling within the breadth of claim 1.

and the substrate.” Ngai, 367 F.3d at 1338 (quoting Gulack, 703 F.2d at 1386) (emphasis added).

Bryan also argues that claim 1 recites three types of cards and Elrod discloses just two types of cards. Br. at 23. However, as discussed above, the broadly-claimed indicia on the cards is merely printed matter with no functional relationship to the substrate. Accordingly, because Elrod discloses cards with various types of indicia, the reference meets these printed matter limitations of claim 1. Moreover, Elrod similarly discloses various card categories, namely, challenge, rescue, name, block, self-challenge, challenge opponent. A30, col. 7, line 38 - A31, col. 10, line 16.

Bryan further argues that a person of ordinary skill in the board game art would construe claim 1 to recite specific cards and would find Elrod not to disclose the cards. Br. at 30-33. However, Bryan did not submit evidence that a person skilled in the art would construe his claims in a way more narrowly than the Board’s way. As discussed above, the Board looked to the printed matter limitations recited in the claim and found such language entitled to no patentable weight. Bryan’s argument lacks any supporting evidence of record to rebut the Board’s determination and should therefore be rejected. See Martahus v.

Video Duplication Serv., Inc., 3 F.3d 417, 420 (Fed. Cir. 1993) (mere argument is not a substitute for record evidence).

C. Claim 11, Which Is Broader Than Claim 1, Would Have Been Obvious In View Of Elrod

Claim 11 recites the following structure: (i) game board; (ii) stage; (iii) travel paths; (iv) tokens; (v) starting area; (vi) consequence cards; and (vii) band member cards. A22-23. Thus, claim 11's structural limitations are in claim 1, except some of claim 1's elements have been omitted, e.g., dice and money not appearing in claim 11. Accordingly, because claim 1, as a narrower claim, would have been obvious, supra, claim 11, as a broader claim, would also have been obvious in view of Elrod. See, e.g., Ormco Corp. v. Align Tech., Inc., 498 F.3d 1307, 1319 (Fed. Cir. 2007) ("[b]ecause claims 10 and 17 were found to have been obvious, the broader claims 1 and 11 must also have been obvious"); In re Muchmore, 433 F.2d 824, 827 (CCPA 1970) ("since the narrower claims were properly rejected for obviousness, the rejection of the broader claims on that ground must also be affirmed").

D. Claim 6, Which Adds To Claim 1 That Cards Be Color Coded, Would Have Been Obvious In View Of Elrod And Hunsberger

Claim 6 depends from claim 1 and adds that band member cards are "color coded." A21. Hunsberger expressly discloses that his sets of cards have different

colors in order to distinguish one set from another set. A63, col. 3, lines 12-16.

Hunsberger recites yellow, red and blue as example colors for his cards. Id.

Thus, the knowledge of using color-coding on different decks of cards for board games was well-known in the art. Accordingly, as the Board determined, “[t]o combine such color-coding with Elrod’s game would yield the predictable result of facilitating grouping of the cards.” A14 (citing KSR Int’l Co. v. Teleflex Inc., 127 S. Ct. 1727, 1739 (2007)). Hunsberger provides the substantial evidence that a person skilled in the board game art would know of the common practice to color code cards and therefore would have applied that knowledge to the board game disclosed in Elrod, thereby rendering claim 6 obvious.

Bryan argues “Hunsberger does not teach, or suggest collectable cards.” Br. at 39. However, a limitation of “collectable” does not appear in claims 6 or 1. See In re Hiniker Co., 150 F.3d 1362, 1369 (Fed. Cir. 1998) (“the name of the game is the claim”) (citation and quotes omitted). Thus, this argument does not correspond with language in the claim. Moreover, Hunsberger broadly teaches color coding various cards for a board game. A63, col. 3, lines 12-16.

VI. CONCLUSION

The Board's findings with respect to its obviousness conclusions are supported by substantial evidence. Bryan has shown no reversible error in this case. Accordingly, this Court should affirm the decision of the Board.

Respectfully submitted,



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CERTIFICATE OF SERVICE

I hereby certify that on December 17, 2008, I caused two copies of the foregoing BRIEF FOR APPELLEE DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE to be mailed by Federal Express, addressed as follows:

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